
Fax

Lilly

Eli Lilly and Company
Lilly Corporate Center
Indianapolis, Indiana 46205
U.S.A.

Lilly Law Division

To:

Company: USPTO
Fax: 703-872-9306
Phone:
Date: 1-24-05

From: Danica Hostettler
Fax: (317) 276-3861
Phone: (317) 276-3711
Total Pages: 4

Subject: X-12301C

If there are any transmittal problems please call the sender.

RECEIVED
CENTRAL FAX CENTER

JAN 24 2005

This facsimile message is intended only for the individual to whom it is addressed and may contain information that is privileged, confidential or exempt from disclosure under applicable law. If you have received this facsimile in error, please notify us immediately by telephone (collect), and return the original message to us at the above address via U.S. Postal Service.

Answers That Matter.

CERTIFICATION OF FACSIMILE TRANSMISSION	
I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office at 703-872-9306 on the date shown below.	

Type or print name of person signing certification	
_____	_____
Signature	Date

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	: Arnold, <i>et al.</i>) Confirmation No.
Serial No.	: 10/774,284) 4429
Filed	: February 6, 2004) Group Art Unit:
For	: Cycloalkylfluorosulfonamide Derivatives) 1625
Docket No.	: X-12301C) Examiner:
) Z. N. Davis

RECEIVED
CENTRAL FAX CENTER

JAN 24 2005

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This response addresses the Office Action mailed December 22, 2004. The paper number was not noted on this Office Action.

Claims 18 through 29 of this application are currently pending. The Examiner has made a restriction requirement under 35 U.S.C § 121. Additionally, the Examiner has required the Applicants under 35 U.S.C § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicants provisionally elect with traverse Group I. Applicants also provisionally elect with traverse the species as disclosed in Example 7 of the present application.

Regarding the provisional election of Group I, the Examiner states that under MPEP § 806.05(h) the claimed product for the instant case can be used in a materially different process of using that product. While Applicants do not acquiesce to the merits of the

Serial No. 10/774,284

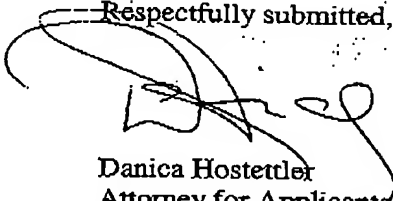
Examiner's statement, MPEP 821.04 (Rejoinder) indicates that if Applicants elect claims directed to the product that are subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim[s] will be rejoined. In the event that Claims 18 through 29 of this application cannot be maintained together, Applicants wish to include Groups I and III in this application pursuant to MPEP 821.04. Preferably, Applicants wish to maintain Claims 18 through 29 in the present application. In support of this request, Applicants respectfully note that this case is a division of Application No. 10/318,483 (now Pat. No. 6,713,516), which is a division of Application No. 10/052,988 (now Pat. No. 6,515,026), which is a division of Application No. 09/744,414 (now Pat. No. 6,358,981). For each of these issued patents, the compound and method claims are issued together. The Restriction Requirement and subsequent clarification provided in the Office Action for the original case (Application No. 09/744,414 (now Pat. No. 6,358,981)) by the Examiner divided the subject matter according to "radicals" within the definition of the formula, not by product and process of using. As such, Applicants respectfully submit that the method claims in Groups II, III, and IV are directed to the compounds of the formula as defined in Group I and that the claims in their entirety (Groups I through IV) are directed to a single invention.

Regarding the provisional election with traverse of the species as disclosed in Example 7 of the present application, the available species for election in view of the genus claims resulting from the earlier Restriction Requirement and subsequent divisional cases in this series provides a species that lacks a naphthyl group. Nonetheless, in order to comply with the requirement to elect a single disclosed species for prosecution on the merits under 35 U.S.C § 121, Applicants provisionally elect the noted species with traverse.

Serial No. 10/774,284

Given the aforementioned points, Applicants traverse this restriction requirement and hereby respectfully request that this restriction requirement be reconsidered.

Respectfully submitted,


Danica Hostettler
Attorney for Applicants
Registration No. 51,820
Phone: 317-276-3711

Eli Lilly and Company
Patent Division/DH
P.O. Box 6288
Indianapolis, Indiana 46206-6288

January 24, 2005